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Klaus Moritzen

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HARNESS, DICKEY & PIERCE, P.L.C.

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EXAMINER

MCINTYRE, CHARLES AARON

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/762,517	Applicant(s) MORITZEN, KLAUS	
	Examiner C. Aaron McIntyre	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 and 94-102 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-91 and 94-102 is/are rejected.
- 7) ☒ Claim(s) 75 and 99 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. The Examiner for this application (i.e. application number 10/762,517) is now C. Aaron McIntyre in Art Unit 3621. Please indicate this change in all future correspondence.
2. This Office action responds to the amendment and arguments filed by Applicant on September 12, 2008 in reply to the previous Office action on the merits, mailed June 13, 2008.
3. The amendments to claims 1, 4, 7, 16, 19, 30, 33, 46, 51-53, 61, 91, and 94-102 by Applicant, in the reply filed on September 12, 2008, are hereby acknowledged.
4. The cancellation of claims 92-93 by Applicant, in the reply filed on September 12, 2008, is hereby acknowledged.
5. The corrected drawings are also acknowledged.
6. Claims 1-91 and 94-102 are pending in this application and have been examined.

Claim Objections

7. Claims 75 is objected to because of the following informalities: It appears that "storage medium" was intended to be --the storage medium--, which change will be assumed for purposes of further consideration of the claims, as to the merits, herein below. Appropriate correction or clarification is required.
8. Claim 99 is additionally objected to because it depends from a cancelled claim 93. Most likely Applicant intended to change this dependency to the claim the cancelled claim depended from, namely claim 91. Therefore for the purposes of further consideration of the claims, it is presumed the claim depends from claim 91. Appropriate correction or clarification is required.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 30-43, 78-79, 83-90, 44-59, 80-81, 91, 94-102 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

11. Claims 30-43, 78-79, 83-90, 44-59, 80-81, 91, 94-102 recite a computer program only.

“Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical ‘things.’ They are neither computer components nor statutory processes, as they are not ‘acts’ being performed.” MPEP §2106.01 I. Because the claims recite only abstractions that are neither “things” nor “acts,” the claims are not within one of the four statutory classes of invention.¹ Because the claim(s) are not within one of the four statutory classes of invention, the claim(s) are rejected under 35 U.S.C. §101.

a. Regarding independent claim 30, Applicant has claimed a prepaid licensing method, “storing information for licensing [a use] on a machine” but this information is not necessarily stored on the machine. Therefore because the machine is not required, this claim is considered to be a computer program per se.

b. Regarding independent claim 44, the same analysis as independent claim 30 applies.

¹ 35 U.S.C. § 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define “things” (or products) while the first category defines “actions” (i.e., inventions that consist of a series of steps or acts to be performed).

- c. Regarding independent claim 91, the added language was only made a part of the preamble. This physical structure must also be positively recited in the body of the claim.
- d. All other claims rejected depend from the above.

Claim Rejections - 35 USC § 112

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 3, 6, 8, 15, 16, 18, 21, 23, 32, 35, 37, 45, 47, 62, 75-83, 98, and 100 as well as any claims depending from these are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claims 3, 6, 8, 18, 21, 23, 32, 35, 37, 45, 47, 62, 98, and 100 are indefinite because they recite the limitation “prohibit operation of ... the machine” which prohibition must necessarily be performed by the machine, therefore it would be unclear to a person having ordinary skill in the art how you can both operate a machine and prohibit operation at the same time. In other words, since the machine is already operating in order to prohibit itself from operating, it was in fact not prohibited from operating.

- Note that in the claims which do not positively recite the machine, it is anticipated that Applicant will correct this by positively reciting the machine.

b. Claim 15 recites the limitation “[a] machine” which is now indefinite because claim 15 depends from claim 1 which now positively recites a machine. Therefore it would be unclear to a person having ordinary skill in the art if there is only one machine or the two machines that are now claimed.

c. Claim 16 recites the limitations a “first code segment” and a “second code segment” but only one code segment is stored in a user machine. Therefore it would be unclear to a person having ordinary skill in the art how the second code segment is being used.

d. Additionally, claim 16 recites a computer-readable medium with at least one code segment stored in a user machine. It is unclear whether Applicant is intending to claim just the computer-readable medium or the combination of the medium and the machine. Therefore because of this ambiguity, it would be unclear to a person having ordinary skill in the art.

e. Claims 75-83 recite the limitation “software option” which is claimed as being opposed to just “software” in the claims. Furthermore, the specification provides that a software option is software; therefore it is unclear how the specification can say that a software option is software and the claims can say that a software option is different than software. In other words, this phrase, in view of the specification, is unclear to a person having ordinary skill in the art. Furthermore, the Examiner can find no indication of there being a hardware option.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1-11, 15-26, 30-40, 44-49, 51-64, 66-91, and 94-101 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2004/0205261 to Osada in view of U.S. Patent No. 6,708,157 to Stefik et al., hereinafter referred to as Stefik.

19. Regarding **claims 1, 15, 16, 30 and 91**, Osada discloses a licensing method, system, and computer readable mediums (“*license management module*” [abstract]), comprising:

storing information (“*FIG. 11 is a diagram showing part of the contents of licensing conditions*” [0040]; [fig. 11]) for licensing (“*licensing*” [0040]) at least one use (“*Total Print Surface Count*” [fig. 11]) of software (“*software of the controller 101*” [0070]; [fig. 1]) on a user machine (“*image forming apparatus 100*” [0058]; [fig. 1]), the information including unique and unchangeable information identifying the machine (“*data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100*” [0088]; [fig. 11]; “*apparatus identification information 800*” [0083]; [fig. 9]), and information for measuring a number of uses of the software on the machine (“*The total print surface count 84 is license information indicative of the total number of print surfaces that can be used*” [0080]; [fig. 8]; “*Total Print Surface Count 1005*” [fig. 11]); and

locally granting a license (“*acquires license information*” [0013]; “*transmitting the license information inputted by the operation of the operator*” [0016]) for the number of uses (“*Total Print Surface Count 1005*” [fig. 11]) of the software (“*software of the controller 101*” [0070]; [fig. 1]) on the machine (“*image forming apparatus 100*” [0058]; [fig. 1]), based upon the stored information (“*storage device that holds the license information*” [0015]; “*license information*” [0016]).

Additionally regarding **claim 1**, Osada discloses a storage medium (“*a storage medium*” [0012]) and a device in the machine for locally granting a license (“*License Management Module 503*” [fig. 5]).

Additionally regarding **claims 16 and 91**, Osada discloses a first code segment (“*Used Resources Totalizing Module 504*” [fig. 5]) and a second code segment (“*License Management Module 503*” [fig. 5])

Additionally regarding **claim 15** Osada discloses a machine including this system (“*FIG. 1 is a block diagram showing the whole arrangement of an image forming apparatus*” [0030]; [fig. 1]).

20. But Osada does not explicitly disclose prepaid (*although logically it appears to be prepaid*).

21. However, Stefik teaches a similar system, which system of Stefik indeed teaches prepaid (“*A ticket is an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service*” [col. 3, ll. 58-67 – col. 4, ll. 1-10]).

22. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Smith so as to have included prepaid, in accordance

with the teaching of Stefik, in order to increase profits by allowing payment in advance of use as well as decreasing administrative expenses associated with billing, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

23. Regarding **claims 2, 17, 31, and 94**, Osada discloses wherein the step of locally granting the license ("*FIG. 20 is a flowchart of a determination process executed by the license management module*" [0049]; [fig. 20]; [fig. 5]) includes counting a number of uses of the software on the machine ("*it is determined in a step S1905 whether or not the total print surface count has exceeded its limit*" [0124]; [fig. 20]; [0049]).

24. Regarding **claims 3, 18, 32, and 95**, Osada discloses prohibiting operation ("*abnormal termination*" [0129]) of at least one of the software and the machine upon the count reaching [a limit] ("*it is determined in a step S1905 whether or not the total print surface count has exceeded its limit*" [0124]; *step S1905 and "Error Termination" step S1910* [fig. 20])

25. But Osada does not explicitly disclose the limit being zero.

26. However, the Examiner takes Official Notice that it is old and well known in the art that a limit could be zero because often systems count down instead of up.

27. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included a limit of zero, in accordance with the Official Notice, in order to provide an alternative system with the ability to count down instead of counting up, since so doing could be performed readily and easily by any

person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

28. Regarding **claims 4, 19, 33, 46, 61, and 96**, Osada discloses checking/examining validity of the software license during at least one of start-up and shut-down of the machine (*“Each of all the program modules managed by the start program management data table 600 requests the license management module 503, before starting a process that uses resources, to determine whether the process can be started”* [0121]; [fig. 20])

29. Regarding **claims 5, 7, 20, 22, 34, 36, 97, and 99**, Osada discloses wherein the step of locally granting the license includes comparing the stored unique and unchangeable information to actual information identifying the machine on which the software will be used (*“when the apparatus specifying information included in the license information acquired by the license information acquisition device and the apparatus identification information stored in the storage device match”* [0013]; [0083]).

30. Regarding **claims 6, 8, 21, 23, 35, 37, 47, 62, 98, and 100**, Osada discloses prohibiting operation of at least one of the software and the machine (*“abnormal termination”* [0129]; *“Error Termination S1508”* [fig. 16]) upon determining that the comparison does not match (*“Apparatus ID’s Match? S1503”* [fig. 16]; [0112]).

31. Regarding **claims 9, 10, 11, 24, 25, 26, 38, 39, 40, 48, 49, 63, 64, and 101**, Osada discloses wherein at least a portion of the stored information is encrypted (*“Preferably, the license information comprises encrypted information”* [0023]).

32. Regarding **claims 44 and 60**, Osada discloses a method and apparatus for granting a license on a machine (*“license management module”* [abstract]; [fig. 1]; [fig. 5]), comprising:
examining information (*“license management device comprising a license information holding device that holds the license information associated with each of programs set to a program to be executed at the start of the image forming apparatus”* which it examines [0021-0022]) for licensing use of software (*“license information associated with each of programs”* [0021-0022]) on a designated machine (*“image forming apparatus”* [0021]), including a number of uses (*“usage limit”* [0022]; [fig. 11]) and unique and unchangeable information identifying the designated machine (*“apparatus identification information 800”* [0083]; *“Serial Number 1001”* [fig. 11]);

comparing (*“match”* [0013]) information identifying a machine to the unique and unchangeable information identifying the designated machine (*“when the apparatus specifying information included in the license information acquired by the license information acquisition device and the apparatus identification information stored in the storage device match”* [0013]; *“apparatus identification information 800”* [0083]; *“data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100”* [0088]; [fig. 11]; [fig. 9]);

determining (“*determining*” [0124]) a number of uses of the software on the machine and comparing the number of uses to the number of [limited] uses (“*it is determined in a step S1905 whether or not the total print surface count has exceeded its limit. This determination is carried out by comparing the total print surface count 84 associated with the relevant module ID in the management information 80 with the total print surface count 1802 associated with the relevant module ID in the used resources totalizing table 1800 held by the used resources totalizing module 504, and determining, based on the result of the comparison, whether or not the total print surface count has exceeded its limit*” [0124]; [fig. 20]; [0049]); and

granting the license (“*acquires license information*” [0013]; “*transmitting the license information inputted by the operation of the operator*” [0016]) for use (“*Total Print Surface Count 1005*” [fig. 11]) of the software (“*software of the controller 101*” [0070]; [fig. 1]) on the machine (“*image forming apparatus 100*” [0058]; [fig. 1]) for the number of uses remaining (difference between “*total print surface count 84*” and “*total print surface count 1802*” [0124]) upon the information identifying the machine matching (“*match*” [0013]) the unique and unchangeable information identifying the designated machine (“*data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100*” [0088]; [fig. 11]; [fig. 9]) and upon the number of uses being determined to be less than the number of prepaid uses (“*determining*” [0124]; *S1905* [fig. 20]; “*Normal Termination S1908*” [fig. 20]).

33. But Osada does not explicitly disclose prepaid (*although logically it appears to be prepaid*).

34. However, Stefik teaches a similar system, which system of Stefik indeed teaches prepaid (*"A ticket is an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service"* [col. 3, ll. 58-67 – col. 4, ll. 1-10]).

35. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Smith so as to have included prepaid, in accordance with the teaching of Stefik, in order to increase profits by allowing payment in advance of use as well as decreasing administrative expenses associated with billing, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

36. Regarding **claim 45**, Osada discloses prohibiting operation (*"abnormal termination"* [0129]) of at least one of the software and the machine upon the number of uses being determined to be at least equal to the number of uses (*"it is determined in a step S1905 whether or not the total print surface count has exceeded its limit"* [0124]; *step S1905 and "Error Termination" step S1910* [fig. 20]; *with exceeding its limit inherently, as in necessarily being the same as equaling the number of uses allowed*).

37. But Osada does not explicitly disclose prepaid (*although logically it appears to be prepaid*).

38. However, Stefik teaches a similar system, which system of Stefik indeed teaches prepaid (*"A ticket is an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service"* [col. 3, ll. 58-67 – col. 4, ll. 1-10]).

39. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Smith so as to have included prepaid, in accordance with the teaching of Stefik, in order to increase profits by allowing payment in advance of use as well as decreasing administrative expenses associated with billing, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

40. Regarding **claims 51, 66, and 84**, Osada discloses determining a number (*“the result of the comparison”* [0124]) of uses of the software remaining (*“whether or not the total print surface count has exceeded its limit”* [0124]).

41. Regarding **claims 52, 67, and 85**, Osada discloses determining a number (*“the result of the comparison”* [0124]) of uses of the software remaining (*“whether or not the total print surface count has exceeded its limit”* [0124]) and indicating (*“status indicative”* [0128]) the number of remaining uses on the machine (*“notification of used resources and the used resources totalizing table”* [0118]; *when there are no remaining uses, “a status indicative of abnormal termination of the present process is set in a step S1910”* [0128]; [fig. 20]).

42. But Osada does not explicitly disclose indicating the number of remaining uses.

43. Regarding **claims 53, 68, and 86**, Osada discloses determining a number (*“the result of the comparison”* [0124]) of uses of the software remaining (*“whether or not the total print surface count has exceeded its limit”* [0124]) and providing an indication on the machine (*“status*

indicative of abnormal termination” [0128]) upon determining that the number of remaining uses exceeds a threshold (“*when there are no remaining uses, “a status indicative of abnormal termination of the present process is set in a step S1910”* [0128]; [fig. 20]).

44. Regarding **claims 54, 56, 69, 70, 87, and 89**, Osada discloses wherein the indication includes a visual indication (“*FIG. 14A or the screen 1303 shown in FIG. 14B is displayed according to the result of the process*” [0105]; [figs. 14A-14B]; “*status line 1140*” [0100]; “You Can Copy” “1 Sheet(s)” [fig. 12]).

45. Although it is the Examiner’s principle position that Osada discloses a visual indication, if it is not clear enough then the Examiner’s alternative position is that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included displaying this information in the status line, in accordance with the further teachings of Osada, in order to provide greater functionality by providing the user with an indication of the status, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

46. Regarding **claims 55, 57, 58, 59, 71, 72, 73, 74, 88, and 90**, Osada discloses as discussed above. Osada does not explicitly disclose wherein the indication includes an audible indication.

47. However, the Examiner takes Official Notice that it is old and well known in the art to use audible indications or alerts.

48. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included wherein the indication includes an audible indications, in accordance with the Official Notice, in order to increase the audience capable of using the device, such as to a visually impaired person who cannot easily see the tiny display in Osada, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

49. Regarding **claims 75, 77, 78, 80, and 82**, Osada discloses wherein the information on storage medium is a software option (“*when the option is a software one*” [0007]; “*license management device*” [0013]).

50. Regarding **claim 76, 79, 81, and 83**, Osada discloses wherein the storage medium stores both the software and the software option (“*storage device that stores ... a plurality of programs ... and a license management device that permits use of the plurality of programs*” [0013]).

51. Claims 12, 13, 14, 27, 28, 29, 41, 42, 43, 50, 65, and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osada in view of Stefik in further view of U.S. Patent No. 6,816,842 to Singh et al., hereinafter referred to as Singh.

52. Regarding **claims 12, 13, 14, 27, 28, 29, 41, 42, 43, 50, 65, and 102**, Osada discloses as discussed above. Osada does not explicitly disclose wherein the machine is a medical device.

53. However, Singh teaches a similar system, which system of Singh indeed teaches wherein the machine is a medical device (“medical imaging equipment” [col. 1, ll. 13-25]).

54. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included wherein the machine is a medical device, in accordance with the teaching of Singh, in order to increase profits by providing a wider range of computer devices upon which the licensing method could be implemented, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

55. Applicant is reminded that “[a] system is an apparatus.” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). Additionally, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. § 101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). The Examiner therefore interprets Applicant's "system" claims (*i.e.* claims 1-15, 75, 60-74, 82) as machine or product² claims.

56. In light of Applicants choice to pursue product claims as noted above, Applicant is reminded that functional recitation(s) in product claims using the word “for,” “adapted to,” or other functional language (*e.g.* claim 1 which recites “adapted to locally grant a license for the number of prepaid uses”) have been considered but are given little patentable weight because

² “Product claims are claims that are directed towards either machines, manufactures, or compositions of matter.” MPEP § 2106 II C.

they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, the Examiner has considered the functional language. However, in a product claim, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2111.04 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

57. Regarding claims 30-59, 78-81, 84-90, Applicant is also reminded that functional recitation(s) using the word “for” (*e.g.* “for licensing at least one prepaid use of software” as recited in claim 30) have been considered but given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

58. If Applicant desires to give the phrase greater patentable weight, the Examiner respectfully recommends Applicant remove “for” and thus recite a positive method step such as -

-storing license information, the license including at least one prepaid use--. Like always, such modification(s) must not constitute new matter and be supported in Applicant's specification.

Response to Arguments

Applicant Argues:

59. Applicant argues that claims 91 and 94-102 now properly recite statutory subject matter.

Examiner's Response:

60. The Examiner respectfully disagrees.

61. Applicant must also properly recite statutory subject matter within the body of the independent claim. A mere recitation in the preamble is not sufficient.

Applicant Argues:

62. Applicant argues that Stefik fails to teach or suggest the amended independent claim 1.

Examiner's Response:

63. The Examiner respectfully disagrees.

64. Independent claim 1, as claimed, can be fully anticipated by Stefik (*but not without argument and additional explanations*). However, the Examiner will not go into great detail here because this argument is now moot in view of the new grounds of rejection above. However, the Examiner respectfully points out that almost any software licensing related reference can anticipate independent claim 1 as claimed, but as a courtesy the Examiner has provided a much more appropriate primary reference which is more closely analogous to Applicant's disclosed invention.

65. A similar argument applies to all other independent claims and the Examiner respectfully disagrees with every argument regarding the independent claims. However, such arguments are moot in view of the new grounds of rejection detailed above.

Applicant Argues:

66. Applicant argues that Stefik fails to teach or suggest the checking validity at start-up or shut-down.

Examiner's Response:

67. The Examiner respectfully disagrees.

68. However, this argument is moot in view of the new grounds of rejection detailed above.

Applicant Argues:

69. Applicant argues that Stefik fails to teach or suggest a medical device.

Examiner's Response:

70. The Examiner agrees and Applicant's arguments are persuasive.

71. Applicant has been provided an appropriate new ground of rejection.

Applicant Argues:

72. Applicant argues that Stefik fails to teach or suggest the exceeding a threshold.

Examiner's Response:

73. The Examiner respectfully disagrees.

74. However, this argument is moot in view of the new grounds of rejection detailed above.

Applicant Argues:

75. Applicant argues that Stefik fails to teach or suggest both a visual and audible indication.

Examiner's Response:

76. The Examiner agrees and Applicant's arguments are persuasive.

77. Applicant has been provided an appropriate new ground of rejection.

Arguments as a whole found persuasive:

78. In short, Applicant's arguments as a whole, filed September 12, 2008, with respect to the rejection(s) of claim(s) 1-102 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the original rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection has been presented above.

Conclusion

79. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

80. Applicant is reminded that patents are written by and for skilled artisans. See e.g. *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) ("patents are written by and for skilled artisans"). The Examiner therefore starts with the presumption that Applicant is a skilled artisan who possesses at least ordinary skill in the art. Consequently, it is the Examiner's position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have

difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicant is hereby given actual notice that if after reasonably reading any reference of record—whether the reference is currently of record or subsequently made of record—if Applicant can not reasonably understand or if Applicant has difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in the reference(s), Applicant should (in his next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicant's response must also state why he either does not understand or why he has difficulty comprehending the offending reference(s). If after properly receiving (i.e. Applicant's response is made of record) both Applicant's request for understanding and the reasons as to why the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) in the offending reference. For all documents or references made of record after this Office Action, Applicant is given actual notice that this paragraph becomes effective when Applicant receives notice that the document or reference is made of record (i.e. this paragraph becomes applicable when Applicant submits an Information Disclosure Statement or when Applicant receives an examiner's Notice of References Cited (Form PTO-892)).

81. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to C. Aaron McIntyre whose telephone number is (571) 270-5401. The Examiner can normally be reached on Monday to Thursday 9-6 ET.

82. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

83. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. A. M./
Examiner, Art Unit 3621
January 9, 2009

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621